

REMARKS AND ARGUMENTS

Claims 4 and 5 are pending in the present application.

Claims 4 and 5 remain rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Applicants respectfully traverse this rejection.

In their previous response, Applicants asserted that the present application would enable one skilled in the art to practice the claimed invention, and demonstrated that the Patent Office has the burden of providing evidence that refutes Applicants' assertion in order to support the enablement rejection. Applicants respectfully submit that the Office has not met its burden in this case. To avoid repetition, Applicants incorporate their previous arguments by reference herein.

The final Office Action does not provide the required specific technical reasons for the rejection, nor does it indicate which part of the scope of the present claims is considered not to be enabled. The "Response to Argument" section of the final Office Action first reiterates the statements from the first Office Action that the claims encompass "hundreds of catalysts" but they are not directed to a "group of specific compounds." However, the claims do recite a specific group, i.e., compounds which are all multi-metal oxide compounds, and more specifically, are all iridium-promoted multi-metal oxides. Then, the Response to Argument once again recites the number of examples in the specification, although Applicants have pointed out that no examples are required to enable the invention. No specific reasons are presented to support the enablement rejection, although "specific technical reasons are always required." M.P.E.P. § 2164.04.

The final Office Action also asserts once more that *Ex parte Sizto* stands for the proposition that "any catalyst compositions" are unpredictable. As Applicants pointed out in their earlier response, the actual comment made by the B.P.A.I. regarding unpredictability was that the characteristics of "metal complexes and electron transfer agents as compared to enzymes" were unpredictable. *Ex parte Sizto*, 9 U.S.P.Q.2d 2081, 1988 Pat. App. LEXIS 26, *7-*8 (B.P.A.I. 1988) (emphasis added). Sizto's claims merely recited "a catalyst" without specifying a particular class of catalysts. *Id.* at *1. The Board upheld the enablement rejection because one class of catalysts may behave very differently from another, i.e., because "the enzyme and non-enzyme catalysts are so divergent." *Id.* at *7. Therefore, the holding in *Ex parte Sizto* cannot be applied at all to a situation like the present case, in which the claims recite only a single class of catalysts.

Moreover, the B.P.A.I. went on to say that "the disclosure is enabling only for claims limited to catalysts which are enzymes." *Id.* at *9. Sizto had provided a "single example disclosing an enzyme catalyst." *Id.* at *7. Accordingly, what the Board found in *Ex parte Sizto* was that a single example of an enzyme catalyst

could enable claims reciting any enzyme catalyst, of which there are millions. Applicants respectfully submit that in the present case, the solely numerical argument made in the final Office Action that the number of examples is insufficient to support Applicants' claims simply cannot alone support an enablement rejection. Specific technical reasons are required, and have not been provided. Therefore, Applicants respectfully submit that the Office Action does not meet the burden of refuting the teaching of Applicants' disclosure, and that the rejection should be withdrawn.

Applicants note that the claim to domestic priority under 35 U.S.C. § 119(e) made in a Preliminary Amendment at the time of filing still has not been acknowledged in the Office Action, and respectfully request that it be acknowledged in the next communication from the Examiner.

Applicants believe that the foregoing remarks have overcome the rejections and that the claims are patentable, and respectfully request that this Response be entered and all claims be passed to allowance at this time. However, if the Examiner has any further objections to the application, Applicants respectfully request that the Examiner contact Applicants' undersigned attorney by telephone at (215) 592-2423 to discuss the remaining issues.

Respectfully submitted,



Kenneth Crimaldi
Attorney for Applicant
Registration No. 40,968
Telephone No.: (215) 592-2423

Rohm and Haas Company
100 Independence Mall West
Philadelphia, PA 19106-2399
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